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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of Dale Burns

Serial No.: 09/182,033 Group Art Unit: 2164

Filed: 10/29/98 Examiner: Kazimi, H.

For: **ELECTRONIC COUPON PROCESSING SYSTEM**

Mail Stop Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed please find the following:

1. Appellant's Reply Brief.

The Commissioner is hereby authorized to charge any fee deficiency, or credit any overpayment, to Deposit Account No. 18-1579. The Commissioner is also authorized to charge Deposit Account No. 18-1579 for any future fees connected in any way to this application. Two copies of this letter are enclosed.

Respectfully submitted,

A handwritten signature in cursive ink, appearing to read "Christopher B. Kilner".

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APPELLANT'S REPLY BRIEF
Application No. 09/182,033

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APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. 41.41

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Alexandria, VA 22313-1450

Dear Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant submit the following:

The Examiner's Answer is incorrect in identifying the filing date of the Appeal Brief as June 2, 2005. The Appellant's Supplemental Brief on Appeal was filed on March 29, 2004.

(i) Real party in interest.

The Examiner's Answer is correct in regard to the real party in interest.

(ii) Related appeals and interferences.

The Supplemental Brief on Appeal filed March 29, 2004 and the Examiner's Answer may not be entirely accurate in regard to related appeals or interferences. The Supplemental Brief on Appeal filed March 29, 2004 was filed under the old rules, merely reinstated the prior

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appeal, and did not include a statement regarding related appeals and interferences. However, Appellant herein states that the present Appeal is related to the prior Appeal No. 2002-1664 of November 18, 2002 from this same Application Ser. No. 09/182,033.

(iii) *Status of claims.*

The Examiner's Answer is correct in regard to the status of the claims.

(iv) *Status of amendments.*

The Examiner's Answer is correct in regard to the status of amendments.

(v) *Summary of claimed subject matter.*

The Examiner's Answer is correct in regard to the summary of claimed subject matter.

(vi) *Grounds of rejection to be reviewed on appeal.*

The Examiner's Answer is partially correct in regard to the remaining grounds of rejection to be reviewed on appeal with respect to claims 38 and 39.

With respect to the remaining pending claims, the Examiner's Action merely states that "the examiner has been affirmed by the board of patent appeals and interferences." This statement is inaccurate since prosecution was reopened by the Patent Office, and independent claims 30 and 40 were each amended to include an additional limitation that was not previously considered by the Board of Patent Appeals and Interferences.

As such, Appellant submits that the issue of whether claims 30-37, 39-47, and 49 are obvious over U.S. Patent No. 4,882,675 to Nichtberger et al. in view of U.S. Patent No. 5,822,735 to DeLapa et al. is to be reviewed on appeal.

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(vii) Argument

Claims 30-37, 39-47, and 49

The Examiner's Answer alleges that Appellant's arguments with respect to claims 30-37, 39-47, and 49 are "moot in view of the board's affirmation mailed November 18, 2002." However, as stated above, these claims include additional limitations that were not previously considered by the Board of Patent Appeals and Interferences.

Simply stated, the Patent Office cannot "have his cake and eat it, too." The Patent Office went to the extraordinary step of reopening prosecution to address claims upon which they were reversed by the Board. The Office then attempted to address the claims upon which the Board had affirmed the final rejection by alleging that they were "withdrawn from consideration." The Appellant is only aware of two circumstances that permit an Examiner to limit prosecution of claims: claims withdrawn from consideration as being drawn to a non-elected invention; and claims in an application that is in condition for allowance except for formal matters under *Ex Parte Quayle*. Neither situation applies in the present application. By reopening prosecution, the Patent Office opened a Pandora's Box allowing the consideration of all "matters not already adjudicated" under 37 CFR § 1.198.

Appellant further notes that MPEP § 1207.02 states that "Grounds of rejection not specifically withdrawn by the examiner and not set forth in the examiner's answer are usually treated by the Board as having been dropped, but may be considered by the Board if it desires to do so."

Nichtberger Anticipation per Board of Appeals

The Examiner's Answer continues to cite to the combination of Nichtberger with De Lapa, yet the Board of Patent Appeals and Interferences previously found Nichtberger to anticipate the claims based upon a particular interpretation of the term "coupon." As such, Appellant again notes that "Grounds of rejection not specifically withdrawn by the examiner and not set forth in the examiner's answer are usually treated by the Board as having been dropped, but may be considered by the Board if it desires to do so." As this ground was advanced by the

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Board, Appellant will address it herein.

Regardless of whether the term “coupon” is interpreted by the Board as “any mode of communication with a consumer or potential consumer offering a specific discount to the consumer wherein the consumer needs to bring such proof back to a store for redemption,” the claims refer to a different term - “unutilized coupon information” - which clearly encompasses what Nichtberger refers to as electronic coupons. Indeed, the limitations of “wherein said at least one means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account, and the system includes means to add unutilized coupon information directly to consumer accounts” in claim 30 makes it clear that the term “unutilized coupon information” is not the same as “coupon” and has a scope encompassing electronic coupons.

The Board’s interpretation of “coupon” also failed to consider that bringing “such proof [of a specific discount] back to a store for redemption” is not limited to physical paper coupons but can include identification means such as frequent buyer cards that offer proof of an offer of a specific discount in the case of electronic coupons. The Board’s narrow view of “coupon” also eviscerates the terms in the definition of “any mode of communication” by limiting it to coupons being capable of being brought into the store with the consumer. Indeed, the definition does not require the communication of the discount be brought into the store, but only “such proof” of a specific discount.

Claims 38 and 48

In regard to claims 38 and 48, the Examiner’s Answer states that “Christensen was relied upon to [teach] the use of [the] Internet to review unutilized coupon information in a consumer’s account based upon input of a consumer’s consumer identification means.” However, Christensen does not teach this.

The equivalent of a consumer identification means in Christensen is the frequency card or the printed coupon list (with bar codes). In the preferred embodiment of Christensen, Virtual

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Coupons™ are delivered and stored on the SELECTSOFT™ software diskette. During redemption, the frequency card is used to check the coupon against the consumer's coupon database. In this embodiment, the consumer runs the SELECTSOFT software on their home computer to browse available coupons and there is no Internet use by the consumer.

In an online embodiment, consumers can provide feedback to enable coupons and may select coupons for redemption. This clearly *teaches against* the claimed limitation that the means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account.

The same paragraph discussing the online embodiment (col. 15:25-36) states that “[i]n-store kiosks may be provided to allow a consumer to log into his or her Virtual Coupon account (i.e., by inserting the SELECTSOFT diskette) to check on available Virtual Coupon discounts, print a shopping list, and select Virtual Coupons for redemption.” This teaching differs from what the Examiner’s Action alleges in that: it does not mention the Internet, the diskette is not the previously-claimed “consumer identification means” since it is not presented at checkout to obtain the discounts, and checking on available Virtual Coupon discounts is not the same as reviewing unutilized coupon information since available coupons in Christensen may not necessarily be enabled (i.e., the consumer might still need to provide feedback to enable an available coupon, as mentioned earlier in the same paragraph) and need to be selected, as mentioned therein.

As to the motivational statement for combining Christensen that was reiterated in the Examiner’s Action, i.e., “allowing the user to access coupons of interest quickly by performing a word search, and review, select, and retrieve coupon information directly from the operations center (see Christensen column 13, lines 14-50),” Appellant notes that the cited portion relates to local use of the SELECTSOFT software from diskette, and has nothing to do with any “operations center” (a term that nowhere appears in Christensen) or any online or Internet use of the Christensen system.

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Indeed, in relation to the prior rejection that was reversed by the Board, Appellant reiterates that Christensen is even less relevant than the prior Official Notice and that the Examiner has again impermissibly engaged in hindsight reconstruction based upon Appellant's disclosure. It appears that even the "Internet" embodiment of Christensen merely involves the substitution of downloaded data on the user's local computer for the software diskette. As stated at col. 8:37-42, "In addition, SELLECTSOFT diskette 310 may be substituted or augmented by downloading of data from an on-line service, Internet connection, E-mail, Website or the like. For example, it is entirely within the spirit and scope of the present invention to provide an interactive Website or BBS to allow a user to download SELLECTSOFT data." There is no discussion of consumers ever interacting online with their Virtual Coupon Database, which is instead used for checking coupon redemption, data mining, etc. by the system itself.

CONCLUSION

For the above reasons, Appellant respectfully submits that the Patent Office has failed to make out a *prima facie* case of obviousness with regard to claims 30-49 and asks that the obviousness rejections be reversed.

Appellant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 18-1579.

Respectfully submitted,



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